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| 09/827,173 | 04/06/2001 | Donald B. Harris | 068540-0102 | 4371 |

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Glenn Law
FOLEY & LARDNER
Washington Harbour
3000 K Street N.W., Suite 500
Washington, DC 20007-5109

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| EXAMINER | |
| FISCHMANN, BRYAN R | |
| ART UNIT | PAPER NUMBER |
| 3618 | |

DATE MAILED: 10/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/827,173

Applicant(s)
HARRIS, ET AL

Examiner
Bryan Fischmann

Art Unit
3618



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 4, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10 and 11 is/are rejected.
- 7) ☒ Claim(s) 1-9 and 12-17 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Apr 6, 2001 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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Acknowledgments

1. The Amendment and Substitute Specification (paper 9) filed 9-4-2002 has been entered.

Specification

2. The disclosure (Substitute Specification) is objected to because of the following:

A) The following recited phrases are unclear, awkwardly worded, and/or grammatically incorrect:

1) Paragraphs 0020-0023 are objected to as they contain "underlined" words.

2) The use of square brackets in paragraph 0035 is objected to, as square brackets are used to indicate deletions in Patent Applications. To avoid potential confusion, the Examiner recommends replacing the square brackets with parenthesis.

3) Paragraph 0047 is objected to, as the paragraph ends with two periods.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the scissor type lifting mechanism as recited in claim 14, and the external combustion engine comprising a gas turbine as recited in claims 16 and 17 must be shown or the features canceled from the claims. No new matter should be entered.

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Claim Objections

4. Claims 1-9, 10 and 12-17 are objected to because of the following:

A) Claim 1 recites "...a battery...said battery sized to supply the peak power demand of the host machine...".

This recited phrase is objected to, as being literally inconsistent with the specification, as best understood.

This recitation is believed to be supported by paragraph 0052 which recites "The electrical power generator 22 may not be capable of supplying the transient peak energy demands of the forklift...This will manifest itself when more electrical current is drawn from the bus than can be supplied from the generator...In this instance the excess power required is supplied by the battery 26".

From this, it is best understood that the battery supplies only power required to make-up the difference between the transient peak power demand and the power output of the generator, as opposed to supplying the entire peak power demand of the host machine as the above recitation implies.

The above recitation is believed to be more accurately worded "said battery sized to supply the portion of the peak power demand of the host machine that is not able to be supplied by the generator", or similar.

Note claim 12 contains a similar recitation.

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B) Line 3 of claim 1 has a blank space between the word "housing" and punctuation following the word "housing".

C) In claim 10, there is no space between the claim number and the preamble.

Although not strictly objectionable, it is also noted that the spacing between claim numbers and the preamble is inconsistent throughout the claims.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicants regard as their invention.

Claims 10 and 11 recite the limitation "the battery compartment". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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8. Claim 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Wild, US Patent 3,497,027.

Wild teaches a method (specification) of replacing a battery in an electric powered machine (vehicle) with a rapidly renewable power source (IC engine) or to a hybrid machine, comprising:

uncoupling the battery from the machine (lines 33-60 of column 4);

removing the battery from a battery compartment (39) of the machine (lines 60-62 of column 4);

placing a rapidly renewable or hybrid power source in the battery compartment (lines 60-62 of column 4 and lines 1-8 of column 5); and

coupling the rapidly renewable power source to the machine (lines 1-8 and 45-48 of column 5).

Allowable Subject Matter

9. Claims 1 and 12 would be allowable if rewritten or amended to overcome the claim objections set forth in this Office action.

10. Claims 2-9 and 13-17 would be allowable if rewritten to overcome the claim objections set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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Response to Applicant's Remarks (paper 9) and Examiner's Comments

11. The Substitute Specification (paper 9) resolved all specification objections made on the first Office Action (paper 7). However, additional specification objections were noted.

12. The Examiner appreciates the clarification by Applicant regarding the AIRTRAX reference cited on the IDS as to whether the Applicant's were the inventor of the power supply module shown on that reference. In response to Applicant's representative question on sheet 6 of paper 9, a declaration is not required regarding the fact that the Applicant's are also the inventor's of the AIRTRAX power supply module, since this fact is now of record in the file wrapper.

13. The Applicant traversed some of the drawing objections made on the last Office Action regarding illustration of claimed matter. Regarding this traversal, the Applicant recites on sheet 6 of paper 9 "Since scissorlifts...are well known in industry, depiction...is unnecessary to explain the claimed invention....with respect to claim 14...one of ordinary skill in the art would understand from the disclosures...that an external combustion engine, particularly a gar turbine, would be contained within box 21 shown in FIG. 4...Therefore, box 21 in FIG 4 of the disclosure in paragraph 59 shows sufficient structure to support the structure recited in claims 16 and 17.

Examiner's Comment - The Examiner, for the most part, agrees with the above.

However, regarding claim 14, it is unclear how the above comments "supersede" the requirements of 37 CFR 1.83(a) which recites "The drawings...must show every feature of the invention specified in the claims...". Regarding claims 16 and 17, the Applicant is basically

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claiming an “alternate embodiment”, or “species” which is generally illustrated separately.

However, 37 CFR 1.83(a) recites “...conventional features....should be illustrated...in the form of a graphical drawing symbol or a labeledbox”. From consideration of this, the Examiner would be willing to “compromise” by withdrawing the drawing objections to claims 16 and 17 if box 21 on Figure 4 were labeled Internal/External combustion engine, or similar.

14. The amendment to the claims has overcome the 35 USC 102 and 103 rejections made on the last Office Action, with the exception of claims 10 and 11.

15. Regarding the rejection of claims 10 and 11, upon further review and in consideration of Applicant’s arguments, the Examiner has now realized that although the best prior art was identified in the last Office Action, the rejection of these claims was not properly set forth by properly utilizing this art. Therefore, claims 10 and 11 are rejected in this Office Action under 35 USC 102 as being anticipated by Wild, as opposed as to being rejected as being unpatentable under 35 USC 103 over Gumpfer in view of Wild in the last Office Action. Accordingly, this action is made non-final.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A) Lynch, et al - teaches IC engine, generator and battery combining to provide peak power in a vehicle - columns 8 and 9

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- B) Brown - teaches battery furnishing peak power demands in a vehicle - column 2
- C) Puskiewicz, et al - teaches power loads for a vehicle (Figure 6)
- D) Hauer - teaches a battery to deal with peak power demands in a vehicle - column 1
- E) Geis - teaches that batteries provide peak power demands in a vehicle - paragraph 0007

17. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Bryan Fischmann whose telephone number is (703) 306-5955. The examiner can normally be reached on Monday through Friday from 7:30 to 4:00.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Brian Johnson, can be reached on (703) 308-0885. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.


BRYAN FISCHMANN
PATENT EXAMINER